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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,067	01/14/2004	Jonathan J. Hull	015358-004031US	5097
20350	7590	09/16/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			WALLERSON, MARK E	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			2626	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/758,067

Applicant(s)

HULL ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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**Part III DETAILED ACTION**

**Notice to Applicant(s)**

1. This application has been examined. Claims 20-32 are pending.

***Information Disclosure Statement***

2. The references listed in the Information Disclosure Statement dated 4/2/2004 have been considered by the Examiner and is attached to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 20, 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 20, 22 recite the limitation that the database comprises image data from unconscious capture archiving of at least a copy, print and facsimile function. It is unclear from the claim when or at what point the image from the copy, print or facsimile function is stored.

## PART 1

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 25, 26, 27, 29, 30, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Morikawa (U.S. 5,613,108).

With regard to claims 25, 27, 29, and 31, Morikawa discloses an email server (6) for performing unconscious archiving of electronic documents in a network environment (column 6, lines 16-31), wherein electronic documents are transferred over a network (figure 1) coupling at least one client computer (2) and at least one document management workstation (3) having at least one database (7) disposed to receive electronic copies of the documents for archiving

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(column 6, lines 16-31), the server (6) operatively disposed to collect electronic image data of an email document transmitted over the network (figure 1), wherein the email document was transmitted in response to a single user input command (column 7, line 66 to column 8, line 6) configured to transmit the email document to a destination, the electronic image data being a copy of the email document transmitted over the network (column 6, lines 16-31); cause said image data to be stored in the at least one database to perform the unconscious capture archiving (column 6, lines 16-31 and column 7, line 66 to column 8, line 6), wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command for transmitting the email document to a destination, wherein the destination and the at least one database are different (column 6, lines 1-65).

With respect to claims 26 and 30, Morikawa discloses a destination client system (figure 1).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20, 21, 22, 23, 28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa (U.S. 5,613,108) in view of Bellemare et al (Bellemare) (U.S. 5,701,183).

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With respect to claims 20, 21, 22, 28, and 32, Morikawa discloses an email server for performing unconscious archiving of electronic documents in a network environment (column 6, lines 16-20), wherein electronic documents are transferred over a network coupling at least one client computer and at least one document management workstation (figure 1 and column 5, lines 60-67) having at least one database (6 or 7) disposed to receive electronic copies of the documents for archiving (column 6, lines 16-20), the server (6) operatively disposed to collect electronic image data of each and every email document in a plurality of email documents transmitted over the network (column 6, lines 16-20) in response to a single user input command (column 7, line 66 to column 8, line 6) the electronic image data being a copy of each and every email document transmitted over the network (column 6, lines 16-31); cause the image data to be stored in the at least one database (7) to perform the unconscious capture archiving, wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command, and the aforementioned steps capture electronic document images of the plurality of email documents transferred over the network (column 6, lines 16-31 and column 7, line 66 to column 8, line 45).

Morikawa differs from claims 20, 22, 28, and 32 in that he does not clearly disclose that the database comprises image data from a copy, print, or facsimile function.

Bellemare discloses an apparatus for the selective archiving of facsimile messages (column 4, lines 24-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Morikawa to store images from a copy, print or facsimile function. It would have been obvious to one of ordinary skill in the art at the time of

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the invention to have modified Morikawa by the teaching of Bellemare in order to obtain a variety of image data in the database.

With regard to claims 23, Morikawa discloses storing addresses for the email (column 6, lines 55-65).

With respect to claim 24, Morikawa discloses storing a transmission date of the email (column 6, lines 55-65).

## **PART 2**

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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10. Claims 25, 26, 27, 29, 30, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Todd (U.S. 5,890,163).

With regard to claims 25, 27, 29, and 31, Todd discloses an email server (column 4, lines 32-34) for performing unconscious archiving of electronic documents in a network environment (column 2, lines 7-30), wherein electronic documents are transferred over a network (figure 2) coupling at least one client computer (20) and at least one document management workstation (26) having at least one database (50) disposed to receive electronic copies of the documents for archiving (column 2, lines 7-30), the server operatively disposed to collect electronic image data of an email document transmitted over the network (figure 1), wherein the email document was transmitted in response to a single user input command (column 2, lines 17-22) configured to transmit the email document to a destination, the electronic image data being a copy of the email document transmitted over the network (column 2, lines 7-30); cause said image data to be stored in the at least one database to perform the unconscious capture archiving (column 2, lines 7-30), wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command for transmitting the email document to a destination, wherein the destination and the at least one database are different (column 2, lines 7-30).

With respect to claims 26 and 30, Todd discloses a destination client system (figure 1 and column 1, lines 52-63).



***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 20, 21, 22, 23, 28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of Bellemare et al (Bellemare) (U.S. 5,701,183).

With respect to claims 20, 21, 22, 28, and 32, Todd discloses an email server for performing unconscious archiving of electronic documents in a network environment (column 2, lines 7-30 and column 4, lines 16-34), wherein electronic documents are transferred over a network coupling at least one client computer and at least one document management workstation (figure 2) having at least one database (50) disposed to receive electronic copies of the documents for archiving (column 2, lines 7-30), the server operatively disposed to collect electronic image data of each and every email document in a plurality of email documents transmitted over the network (column 2, lines 7-30) in response to a single user input command (column 2, lines 7-30) the electronic image data being a copy of each and every email document transmitted over the network (column 2, lines 7-30); cause the image data to be stored in the at least one database (50) to perform the unconscious capture archiving, wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command, and the aforementioned steps capture electronic document images of the plurality of email documents transferred over the network (column 2, lines 7-30).

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Todd differs from claims 20, 22, 28, and 32 in that he does not clearly disclose that the database comprises image data from a copy, print, or facsimile function.

Bellemare discloses an apparatus for the selective archiving of facsimile messages (column 4, lines 24-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Todd to store images from a copy, print or facsimile function. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Todd by the teaching of Bellemare in order to obtain a variety of image data in the database.

With regard to claims 23, Todd discloses storing addresses for the email (column 5, lines 12-37).

With respect to claim 24, Todd discloses storing a transmission date of the email (column 7, lines 24-32 and column 9, lines 4-7).

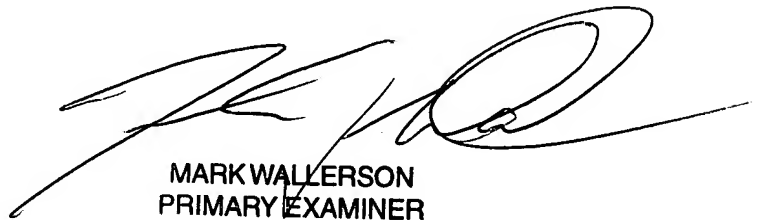
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626



MARK WALLERSON  
PRIMARY EXAMINER